

REMARKS

Claims 1-4, 6-24, 26-44 and 54-99 are now pending in this application. Claims 5, 25, and 45-53 were cancelled. Claims 18-20 were allowed. Claims 15 and 44 were rejected as indefinite under 35 U.S.C. 112, second paragraph. Claims 1-4, 6-17, 21-24, 26-43 and 54-99 were rejected. Claims 1, 4, 7-10, 13, 15-19, 21, 23-24, 27-31, 33, 44, 97-99 are amended. Claims 100-108 are added, drawn to the subject matter as defined in the canceled claims 45-53, which were objected to, but held to be allowable in the Office Action mailed on December 23, 2004.

Amendment to claims

Claims 1, 4, 7-10, 13, 16-19, 21, 23-24, 27-31, 33, and 97-99 are amended to correct formality inconsistency.

Claim 15 is amended to recite “the aliphatic group of R₃”.

Claim 44 is amended to recite “a hydroxylated functional compound”.

Rejection under 35 U.S.C. 112

The Examiner rejected claims 15 and 44 as indefinite on the basis that the term “the aliphatic” in claim 15 and the term “a hydroxylated functional” in claim 44 are unclear. Both claims claim 15 and 44 are amended as suggested by the Examiner. Removal of rejections are respectfully requested.

Rejection under 35 U.S.C. 103(a)

Claims 1-4, 6-17, 21-24, 26-43, and 54-99 were rejected as obvious over U.S. Patent No. 5,605,696 to Eury et al. (“Eury”) in view of U.S. Patent No. 4,304,767 to Heller, et al. (“Heller”) on the basis that Eury describes a stent coated with a polymer that can be a polyorthoester and

that Heller describes a general formula of a polyorthoester and some polyorthoester species with similar structures as the ones defined in the claims. The applicants respectfully disagree.

Eury describes a drug loaded polymeric material containing a therapeutic drug that can be applied to a structure of an intravascular stent. At col. 4, lines 37-54, Eury states that the material can include a polyorthoester (line 52). Heller describes polymers formed of di-ketene acetals and a polyols. The polymers are suitable as carriers or matrices for drug and other beneficial material agents used for therapeutic purposes (col. 1, lines 10-14). The polymers formed of the acetals and the polyols in Heller are sub-species of the polyorthoester mentioned in Eury.

However, there is no motivation to combine Eury with Heller. Under the U.S. patent law, prior to combining the teachings in different references, the Examiner has to show that there is motivation in the cited prior art reference for one of ordinary skill in the art to combine the teachings of the two references (see In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998); see also MPEP §2143.01). Here, to one of ordinary skill in the art, what is missing in Eury is the motivation to use a polyorthoester formed by polycondensation of a diketene and a polyol or diol as provided in Heller, and what is missing in Heller is the motivation to use the specific polyorthoester described therein to form a coating as described in Eury. The applicants respectfully submit that the Examiner failed to show this motivation.

Eury describes a drug loaded polymeric material for forming a coating on a stent. The polymeric material can be, among many different biodegradable polymers, a polyorthoester, a genus that may encompass millions of chemical species having many different structures and can be made from different starting materials by many different methods. Eury certainly does not

provide any motivation for one of ordinary skill in the art to use the polymers described in Heller for forming a coating on a stent.

Heller, on the other hand, describes polyorthoesters formed of diketenes and polyols for forming drug delivery matrices or carriers. While a coating on a stent can have a drug included therein, a coating on a stent does not have to include a drug. Further, a coating, even if it includes a drug, would be a subset of matrices or carriers for the drug, which can take many other different mechanical or physical forms. Heller does not provide any motivation for one of ordinary skill in the art to use the polyorthoesters formed of diketenes and polyols described therein to form a coating on a stent as described in Eury.

Accordingly, claim 1 is allowable. Claims 2-4 and 6-17, 25-43, 45-99 and new claims 100-108 depend on claim 1 and are allowable for at least the same reason.

The applicants appreciate the allowance of claims 18-20.

Examination and allowance of the claims are respectfully requested. If the Examiner has any suggestions or amendments to the claims to place the claims in condition for allowance, applicant would prefer a telephone call to Zhaoyang Li for approval of an Examiner's amendment. If the Examiner has any questions or concerns, the Examiner is invited to telephone the undersigned attorney at (415) 393-9885.

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